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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/316,313 05/21/99 PRATAP

R U-012254-3

000140  
LADAS & PARRY  
26 WEST 61ST STREET  
NEW YORK NY 10023

HM12/0222

EXAMINER

HUANG, E

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

02/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/316,313

Applicant(s)

PRATAP ET AL.

Examiner

Evelyn Huang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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***Continued Prosecution Application***

1. The request filed on 1-26-2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/316313 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 11-21 are pending.

***Claim Rejections - 35 USC § 103***

3. The 103 rejection over Andersag is maintained for claims 11-20 for reasons set forth in the office action mailed on 11-8-1999. The rejection is applicable to the new claim 21, directed to the compound.

Andersag generically teaches the instant compound, its method of use and the process of making the compound (page 1, columns 1-2). Specific compounds and their process of make are described in Examples 10, 11 (page 2, column 2).

Applicant argues that the instant has an amino- methyl-butyl-amino whereas the compound of Example 11 (page 2, lines 45-48) has an amino n-pentyl-amino and an additional methyl on the butyrolactone. However, amino- methyl-butyl-amino and amino n-pentyl-amino are adjacent homologs, and they are optional choices within amino-alkyl-amino while methyl on the butyrolactone is also optional (page 1, lines 44-45; 49-52). An example of the butyrolactone without methyl substitution is shown in Example 10 (page 2, lines 8-9). At the time of the invention, one of ordinary skill in the art would be motivated to modify the compound of Example 11 by replacing with the alternative substituents to arrive at the instant invention since Andersag had clearly taught that any species within the disclosed genus would be effective in treating malaria. In the absence of unexpected results, the instant compound, the method of use and the process for making the compound thereof remain obvious over Andersag.

Applicant argues that Andersag only generically teaches the use of the compound to treat malaria, among other uses. However, Andersag teaches that this class of compounds is particularly useful for combating malaria parasites (page 1, column 1, lines 7-8). Guided by the

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teaching of Andersag, one of ordinary skill in the art would be motivated to use any of the species within the disclosed genus to treat malaria. While applicant recites the various advantages of the instant compounds over primaquine, advantages over the prior compound is not described and the instant therefore remains obvious over the prior art of record in the absence of unexpected results.

*Conclusion*


4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 703-305-7247. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kight can be reached on 703-308-0204. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Evelyn Huang  
Primary Examiner  
Art Unit 1625

February 17, 2001